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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/030,937	05/24/2002	Dominique Roecklin	111664	3978

7590 09/01/2005

Oliff & Berridge
PO Box 19928
Alexandria, VA 22320

EXAMINER

MARTINELL, JAMES

ART UNIT	PAPER NUMBER
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1634

DATE MAILED: 09/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/030,937

Applicant(s)

ROECKLIN ET AL.

Examiner

James Martinell

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 June 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 19,22,23,26-29,33 and 60-62 is/are pending in the application.
- 4a) Of the above claim(s) 33 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 19,26-29,60 and 61 is/are rejected.
- 7) ☒ Claim(s) 22,23 and 62 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 6/21/05 & 1/15/02 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

S.O.D

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Claim 33 is withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on June 21, 2005. Applicants' argument (response filed June 21, 2005, page 8) is not convincing because applicants do not point to a common special technical feature shared by the elected claims and claim 33.

The requirement is still deemed proper and is therefore made FINAL.

Copies of references submitted in previous filed May 24, 2002 have not been considered because no list of references is contained in the instant application. Such a list is required. See MPEP 609). Applicants assert that Information Disclosure Statements were submitted on June 4, 2002 and June 11, 2002, (response filed June 21, 2005, page 7), but no Information Disclosure Statements with those dates are in the USPTO Image Wrapper File. Applicants further assert that the USPTO has acknowledged receipt of and IDS. The Office action mailed June 21, 2004 acknowledges the receipt of copies of references, but not of an IDS.

Applicants' remarks in connection with the amendments to the drawings and the amendments to the Brief Description of the Drawings are not understood. First, Figures 1-3 as submitted in the amendment filed June 21, 2005 include one sequence in each of the figures. Second, the specification has been amended to include SEQ ID NOs in the Brief Description of the Drawings in reference to Figures 1-3. Thus, as it stands, there is no reason to object to the drawings. However, applicants assert that Figures 1-3 have been amended to include no sequences. This remark does not correspond to what is actually in the file. Finally, if Figure 1-3 did not contain sequences, it is not understood why the Brief Description of the Drawings should refer to SEQ ID NOs in Figure 1-3. Clarification is requested.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 27, 29, and 61 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims are vague, indefinite, and incomplete.

- (a) The recitation of "belonging to the same family of proteins chosen from Perlecan, the precursor of the retinal-binding plasma protein, GM2 activator protein, calgranulin B and saposin B" (claim 27) is vague and indefinite because there are no art-accepted definitions of any of these terms, nor are they defined with specificity in the instant application. Thus, the metes and bounds of the claim are not clear. Applicants' assertion (response filed June 21, 2005, page 9) is not convincing because the definitions on pages 6-7 of the instant application are insufficient to provide clear metes and bounds to the claimed subject matter. For example, at page 6, first full paragraph of the specification it is stated: "The expression protein family is understood to mean all the proteins encoded from the same DNA gene and which result from a differential multiple splicing of the gene and/or different reading frame." Applicants do not explain or even hint at how one of skill in the art could determine whether a given polypeptide belongs in this sort of family with knowledge of a polypeptide sequence. If the expression protein family includes sequences that are read in different reading frames, then it is possible for two proteins to be considered to belong to the same family even though they share minimal polypeptide sequence information. The listing of a few vague examples is insufficient to define the boundaries of the claim.
- (b) The recitation of "ligand specific for said polypeptide" (claim 29) is vague and indefinite because specificity of binding depends upon the presence of molecules in the reaction mixture that compete for binding to the target polypeptide. Thus, claims are vague, indefinite, and incomplete in the absence of mention of the potential competing molecules. Applicants' assertion (response filed June 21, 2005, page 9) is not convincing because applicants do not address the reason for the rejection.

Claim 19 is rejected under 35 U.S.C. 102(b) as being clearly anticipated by Xie et al (Biochem. Biophys. Res. Comm. 177: 1217 (1991)). Xie et al discloses a polypeptide with the SEQ ID NO: 68

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polymorphism. See Figure 1, amino acid position no. 27 which can be either Ala or Thr. The polymorphism of SEQ ID NO: 68 contains a Thr at this position.

Claims 26, 28, 29, 60, and 61 are rejected under 35 U.S.C. 103(a) as being unpatentable over Xie et al (Biochem. Biophys. Res. Comm. 177: 1217 (1991)) in view of Li et al (J. Biol. Chem. 270: 24246 (1995)). Xie et al discloses a polypeptide with the SEQ ID NO: 68 polymorphism. See Figure 1, amino acid position no. 27 which can be either Ala or Thr. The polymorphism of SEQ ID NO: 68 contains a Thr at this position. Li et al teaches the detection of GM2 Activator Protein using monoclonal antibody assays (*e.g.*, see the Materials section on page 24247). It would have been obvious for one of ordinary skill in the art at the time the invention was made to assay for the GM2 Activator Protein polypeptide of Xie et al using the methods of Li et al in order to detect GM2 Activator Protein.

Claims 22, 23, and 62 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James Martinell whose telephone number is (571) 272-0719. The fax phone number for Examiner Martinell's desktop workstation is (571) 273-0719. Only documents such as those intended for use in a personal or telephone interview should be faxed to the examiner's desktop workstation. Any Official Communication to the USPTO should be faxed to (571) 273-8300.

The examiner works a flexible schedule and can be reached by phone and voice mail. Alternatively, a request for a return telephone call may be e-mailed to james.martinell@uspto.gov. Since e-mail communications may not be secure, it is suggested that information in such requests be limited to name, phone number, and the best time to return the call.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Jones, can be reached on (571) 272-0745.

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OFFICIAL FAX NUMBER

The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300. Any Official Communication to the USPTO should be faxed to this number.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to (571) 272-0547.

Patent applicants with problems or questions regarding electronic images that can be viewed in the Patent Application Information Retrieval system (PAIR) can now contact the USPTO's Patent Electronic Business Center (Patent EBC) for assistance. Representatives are available to answer your questions daily from 6 am to midnight (EST). The toll free number is (866) 217-9197. When calling please have your application serial or patent number, the type of document you are having an image problem with, the number of pages and the specific nature of the problem. The Patent Electronic Business Center will notify applicants of the resolution of the problem within 5-7 business days. Applicants can also check PAIR to confirm that the problem has been corrected. The USPTO's Patent Electronic Business Center is a complete service center supporting all patent business on the Internet. The USPTO's PAIR system provides Internet-based access to patent application status and history information. It also enables applicants to view the scanned images of their own application file folder(s) as well as general patent information available to the public.

For all other customer support, please call the USPTO Call Center (UCC) at 800-786-9199.


James Martinell, Ph.D.
Primary Examiner
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8/29/05